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Re: 3rd Appeal Brief, GAU 3618 Ser. No. 09/995,097

RECEIVED
SEP 30 2003
GROUP 3600
Appellant: John Bromer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: **Gerald Klebe**

5 GAU: **3618**

Title: **DORSIFLEXION SKATE BRAKE**

Serial No.: **09/995,097**

Filed: Nov. 27, 2001

This paper: **September 24, 2003**

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PETITION TO DIRECTOR

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Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

The Appellant petitions under 37 CFR § 1.181 for the Director to instruct the Examiner to make the Table of Authorities, submitted on even date herewith, an integral attachment to the Supplemental Appeal Brief.

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The Appellant requests that the Director act on this petition and not permit SPE Johnson to take unrelated action. In response to the previous petition of March 19, 2003, Examiner Johnson indicated that the finality of the previous rejection would be withdrawn (which was not requested by the Appellant), but then immediately issued a new final rejection. The Appellant petitioned for withdrawal of the new finality on July 23, 2003, but as of the date

25 of this paper (64 days later) had received no decision. This action prevented the Appellant from amending his claims, which might have led to some resolution of the issues; did absolutely nothing to advance the examination, while using up PTO time and resources; and delayed the Appellant's cause and shortened the term of any resulting patent.

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The following repeats portions of the text of the Petition on Holding of Non-Compliance of Appeal Brief submitted on March 19, 2003:

In the Notification of Non-Compliance mailed on February 25, 2003, holding the Brief filed on December 12, 2002 to be non-compliant, the Examiner correctly pointed out formal errors by the Appellant. However, the Examiner has held the Brief non-compliant because the Appellant cited as authorities a model and a declaration in support of the model, and the
5 Examiner required that the model and declaration should be deleted as authorities and not mentioned. The Appellant respectfully traverses this requirement.

(1) MPEP § 1207 states that “Entry of a ... new affidavit ... is not a matter of right,” but the Appellant's model and declaration are not “new.” The model was shown to the Examiner and
10 SPE Johnson at a personal interview on May 15, 2002, after the first Office Action, and the declaration was submitted with the Amendment After Final Rejection on September 25, 2002, which was the first paper in reply to the Final Office Action (mailed September 16, 2002). Under MPEP § 715.09, a declaration is timely if submitted after final rejection with a first reply after the final rejection, for the purpose of overcoming a new ground of rejection made in the
15 final rejection.

That was the Appellant's purpose.² The Appellant submitted the declaration in support of the model because of the Examiners' assertion that the model shows features not in the specification, and that it was built after the Appellant filed his application. The new rejection under § 112, first paragraph appeared to be based on the Examiners' opinion about the model; the
20 § 112, first paragraph rejection was made only *after* the Examiners saw the model, and is not

² The Appellant notes that overcoming a rejection or objection is the only reason that any action is ever undertaken by a patent applicant in response to an Office Action, and the fact that the Appellant submitted the declaration is *prima facie* evidence that his purpose was to overcome a rejection.

related to any amendments by the Appellant. The only amendment to the specification before the final rejection was to add "aromatic polyamide" because Kevlar was objected to as a trademark.³

The Appellant noted in his Amendment After Final Rejection (end of page 5), "This rejection is new and is not based on any amendment to the claims (it is based on the specification), so the Action should have been non-final." That was not traversed by the Examiner.

In the same paper, the Appellant also explained the relevance of the declaration (bottom of page 4), as follows: "(c) Attached is an affidavit [actually the declaration] stating that the working model demonstrated to the Examiner at the personal interview of May 15, 2002 was built before the filing of this application. That model incorporated the flexible-belt brake shoe of Fig. 3 but used a solid wooden arm in place of wheel W2, which had been removed; a pin went through the truck sides and the arm at the W2 axle hole. That model demonstrates that the Applicant contemplated, at the time of filing: braking against the tread of wheel W1; a non-planar design; and hinge support on both sides of the arm. The fact that the Examiner is adopting a position contrary to the model is believed to indicate that the Examiner did not give the model weight. With the submission of this affidavit, the Examiner must give weight to the model or else state on the record the reasons why he will not." The Examiner has not so stated on the record.

In sum, the model and the declaration were *already part of the record* before the Notice of Appeal, and the Examiner has no authority to remove them from the record, even if (for argument's sake) he had the authority not to admit them.

³In fact, that amendment to the specification was not even entered, due to a clerical error by the Appellant.

(2) The Examiner states (line 9 of "Re: Item 1" on page 2) that reference to the model demonstrated at the interview of May 15, 2002 is not appropriate because it has "not been made available." However, the Appellant certainly made it "available" at the interview, and no one has asked to see it since. MPEP § 608.03(a) prohibits the Appellant from simply sending the model to the PTO. The Appellant remains willing to show it to anyone at the PTO on request, and he plans to take it before the Board. The model is not "unavailable" and in any event there is no citation or argument as to why it should be "available."

(3) The Examiner continues to question the model, and even after receiving the declaration stated that the model "showed features not in the application originally filed" (Advisory Action of October 7, 2002). Because the Examiner continues to reject the truth of the Appellant's declaration, and because the § 112, first paragraph rejection was made after the model was exhibited and not in response to any change in the specification, the model and the declaration appear to be highly relevant. The existence of a working model bears on the rejection under § 112, first paragraph, under MPEP § 2164.01(a), which lists "The existence of working examples" as one factor to be considered on the question of undue experimentation. The Appellant explained this in the Brief at page 8, line 24 through page 9, line 6.

(4) The Examiner stated to the Appellant during a telephone conversation on March 17, 2003 that the model and the declaration are unrelated to the claims, and the Examiner states in the Notice of Non-Compliance (page 2, eighth line from the bottom) that reference to the model is not appropriate because it "has no bearing on the rejections." With respect, that determination is properly made by the Board, not the Examiner. If the model and declaration are truly unrelated to the claims, the Board can simply disregard them.

(5) The Examiner applies 37 CFR 1.192(c) against the Appellant's authorities on the grounds that they are "out of permitted order." That is not correct because the required portions of the Brief *are* in order, and 37 CFR 1.192(c) does not mention appendices or preambles. The Examiner mis-reads 37 CFR 1.192(c) to exclude anything other than the required portions; the Authorities section which the Examiner asserts is out of order is not one of the nine items that are required by 37 CFR § 1.192(c) to be in order and therefore the Brief is actually in compliance with § 1.192(c).

The MPEP at page 1200-11, tenth line from the bottom (§ 1206, 8th Edition), reads,

A brief is in compliance with 37 CFR 1.192(c) as long as it includes the items (1) to (9) in the order set forth.

There is no mention of additional portions of the Brief, such as a Table of Authorities.

(6) The Appellant understands that his statement of the status of the amendments is not correct because the after-final Amendment of September 25, 2002 was *not* entered (it overcame a rejection, so the Appellant assumed it was entered; see Brief at page 2, lines 2-7) but the Examiner states that the Amendment *will* be entered *when* a compliant Brief is submitted. The Examiner thus requires the Appellant to *predict* whether the Examiner will hold his Brief to be non-compliant, and to submit to the Board a version of the claims that will not be under consideration by them. Clarification is requested. Should the Appellant give both the unamended version for formal compliance, and also the amended version for the Board to review? Also, the Appellant desires to know if his amendment to the specification was entered, or was not.

(7) The Examiner states that the Appellant gave an argument on grouping under the wrong heading. This is not contested. However, the paragraph at the top of page 4 of the Notification of Non-Compliance is respectfully believed to confuse claim grouping with issues. The claims were all rejected under § 112 but the rejections under § 102 split the claims. Each rejection raises one issue. This is set out in the Brief at page 5, lines 9-12. Each of the issue labels (i), (ii), and (iii) listed on page 5, lines 9-12 is found in the Argument section and the rejections are re-stated under each heading in the Argument section.

Respectfully submitted,

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